

Application No. 10/800,444
Reply to Office Action of November 24, 2006

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REMARKS

I. INTRODUCTION

Claims 1-56 are pending. Claims 1, 38, 48, and 49 are independent claims. In the Office Action, claims 16 and 49-56 were objected to for certain informalities. Claims 15, 36, and 37 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Claims 2-3, 15, 19, and 36-48 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Claims 1-5, 10, 14, 22-23, and 31 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 7,110,993 ("Soulanille"). Claims 7-9, 11-12, 16-18, 20, 21, 24-30, and 32-35 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Soulanille in view of U.S. Patent Application Publication No. 2003/1077076 ("Might"). Claims 16 and 24 were rejected under Section 103(a) as allegedly unpatentable over Soulanille in view of U.S. Patent Application Publication 2004/0167856.¹ Claims 17-18 and 26-27 were rejected under Section 103(a) as allegedly unpatentable over Soulanille. Claims 20-21 were rejected under Section 103(a) as allegedly unpatentable over Soulanille in view of United States Patent No. 6,564,208 ("Littlefield"). Claims 25 and 28-29 were rejected under Section 103(a) as allegedly unpatentable over Soulanille in view of Official Notice. Claim 30 was rejected under 35 Section 103 as allegedly unpatentable over Soulanille in view of U.S. Patent Application Publication No. 2001/0003177 ("Scheda"). Claim 32 was rejected under 35 Section 103 as allegedly unpatentable over Soulanille in view of U.S. Patent Application Publication No. 2004/0186769 ("Mangold"). Claim 33 was rejected under 35 Section 103 as allegedly unpatentable over Soulanille in view of Mangold and further in view of Official Notice. Claim 32 was further rejected under 35 Section 103 as allegedly unpatentable over Soulanille in view of U.S. Patent Application Publication No. 2002/010015 ("Acres"). Claim 33 was further rejected under 35 Section 103 as allegedly unpatentable over Soulanille in view of Acres and further in view of Official Notice. Claims 34-35 were rejected under Section 103 as allegedly unpatentable over Soulanille in view of Acres. Claims 38-42 and 44-46 were rejected under Section 103 as allegedly unpatentable over Soulanille in view of Official Notice. Claims 43 and 51 were rejected under Section 103 as allegedly unpatentable over Soulanille in view

¹ The Office Action ascribes U.S. Patent Application Publication 2004/0167856 to "Corn et al." However, U.S. Patent Application Publication 2004/0167856 in fact lists Shibasaki, et al. as inventors. Applicants believe that the Examiner intended to cite U.S. Patent Application Publication 2004/0167845, which lists Corn et al. as inventors.

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of Official Notice and further in view of Might. Claims 49-50 and 52-56 were rejected under Section 103 as allegedly unpatentable over Soulanille in view of Official Notice.

Claims 1, 2, 10, 15, 16, 19, 36, 38, 43, 48, 49, 53, and 54 are amended herein. At least for the reasons set forth below, Applicants respectfully submit that all pending claims are in condition for allowance over the prior art of record. Further, Applicants reserve the right to set forth further reasons supporting the patentability of their claims, including reasons supporting these separate the patentability of their dependent claims not explicitly addressed herein, in future papers.

Initially, Applicants would like to thank the Examiner for the courtesy of the interview conducted with Applicants' representative on February 14, 2007. During this interview, the Examiner and Applicant's representative discussed the application of Soulanille to claim 1. The Examiner preliminarily agreed that the foregoing amendment to claim 1 overcomes Soulanille. Support for the present amendments to independent claims 1, 38, 48, and 49 can be found throughout Applicants' Specification. In particular, paragraphs 280-294 of Applicants' Specification discusses group based processing. Further by way of example, Figures 13-17, along with the descriptions of those Figures beginning at paragraph 351, also provide support for the foregoing claim amendments.

II. CLAIM OBJECTIONS

Claim amendments herein are believed to have cured the Examiner's objections to claims 16 and 49-56.

III. SECTION 112 REJECTIONS

Amendments herein are believed to have addressed the Examiner's Section 112 rejections of claims 2-3, 15, 19, and 36-48, 36, and 37.

III. PRIOR ART REJECTIONS

Independent claims 1, 38, and 48, as amended, recite "a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to said request." Further, claims 1, 38, and 48 each specify that the request is a "request from a user." Independent claim 49, as amended, includes similar recitations. In the Office Action, the Examiner asserted that Soulanille "discloses a plurality of groups," and that "[t]he groups may be taken as the group of paid listings and the group of unpaid listings." (Office Action, pages 6-7.) Applicants disagree that Soulanille teaches or suggests "a plurality of groups" as recited in claim 1, and moreover, assuming arguendo that Soulanille

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"discloses a plurality of groups," Soulanille does not teach or suggest that "each said listing in said response is associated with at least one said, each said group being determined at least in part according to said request."

Soulanille uses a "search engine Web server 24 [that] includes a search database 40 comprised of search listing records used to generate search results in response to user queries." (Soulanille, column 7, line 62-64.) The database 40 may include unpaid listings, or it is possible that a "search result list also includes non-paid listings that . . . are generated by a conventional World Wide Web search engine." (Soulanille, column 9, lines 13-15; see also Soulanille, column 17, lines 17-19.) Thus, "[t]he original search query entered by the remote searcher is used to generate unpaid listings through the conventional search engine." (Soulanille, column 17, lines 21-23.) These "[u]npaid listings . . . are displayed following the lowest-ranked paid listing." (Soulanille, column 17, lines 13-15.) In other words, in the system of Soulanille, listings are segregated into paid and unpaid listings not at all determined by a request from a user, but rather according to whether listings are found in the database 40 of Soulanille and marked as paid listings, or whether listings are found by a search through a conventional Web search engine. In short, even if Soulanille's paid and unpaid listings read on the groups recited in claim 1, which they do not, Soulanille's grouping of paid and unpaid listings is plainly not "determined at least in part according to" a "request from a user."

For at least the foregoing reasons, claims 1, 38, 48, and 49 are in condition for allowance over the cited prior art. Further, claims 2-37 are in condition for allowance at least by reason of their dependence from claim 1. Claims 39-47 are in condition for allowance at least by reason of their dependence from claim 38. Claims 50-56 are in condition for allowance at least by reason of their dependence from claim 49.

IV. SECTION 103 REJECTIONS – OFFICIAL NOTICE

In rejecting claims 2 and 3, the Examiner took Official Notice "that it is well known to make selections based on multiple factors together." (Office Action, page 7.) In rejecting claims 25, 28, and 29, the Examiner took Official Notice "that it is well known for auctions to have minimum bid increments." (Office Action, page 15.) In rejecting claim 33, the Examiner took Official Notice "that is well-known for a number of hits or period of time to influence a per-hit fee." In rejecting claims 38-47, the Examiner took Official Notice "that is well-known to prioritize listings in non-paid tiers returned by search engines." (Office Action, page 21.) In rejecting claims 49-56, the Examiner

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took Official Notice "that it is well-known to input programs, files, in particular criteria into computers." (Office Action, page 25.) With respect to each instance in which Official Notice has been taken, Applicants hereby seasonably challenge the Official Notice taken by the Examiner. See 37 CFR 1.104(d)(2) and MPEP § 2144.03. Therefore, the Examiner is required to produce documentary proof as evidence of the Official Notice in response to this communication. In the event that the Examiner does not produce documentary proof, it is respectfully submitted that the rejections based on Official Notice – i.e., the rejections of claims 2, 3, 25, 28, 29, 33, 38-47, and 49-56 – must be withdrawn for at least this reason.

V. CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 66703-0014. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: February 15, 2007

Respectfully submitted,

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